

REMARKS

In accordance with the foregoing, claims 1 and 2 have been amended.

Claims 1-7 are pending and under consideration.

ENTRY OF AMENDMENT UNDER 37 C.F.R. § 1.116:

Applicants request entry of this Rule 116 Response because the amendments of claims 1 and 2 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and the amendments do not significantly alter the scope of the claims and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

REJECTION UNDER 35 U.S.C. § 102:

In the Office Action, at page 2, 1, 2, and 4-7 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,343,866 to Cao et al. ("Cao"). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

According to the Office Action, FIGS. 20(A), 20(B), 29, and 71 and corresponding descriptions as provided in column 19, line 30, to column 20, line 11, teach a mirror shape being adjustable or variable to suit to any required form. Independent claim 1 is amended to further clarify the surface-shape variable mirror unit.

It appears that the mirror of Cao is being interpreted as being variable because in one embodiment, a concave mirror may be used, and in another embodiment the mirror may be replaced with a convex mirror. FIGS. 20(A) and 20(B) of Cao are diagrams illustrating two separate apparatuses, where one apparatus includes a mirror 254 being a convex mirror. See column 19, lines 30-43. In FIG. 20 (A), the apparatus uses the convex mirror where a beam shift

is magnified. FIG. 20(B), the mirror 254 is concave, where a sign of dispersion is inverted. However, the mirror 254 in both embodiments does not include a transformable surface shape, rather, the mirror 254 is exchanged or replaced with a convex mirror or a concave mirror. The mirror 254 is not transformable. Thus, Cao fails to teach or suggest, "a surface-shape variable mirror unit returning the angular dispersed beams to the angular dispersion unit and comprising a transformable surface shape where the stage units transform the mirror unit to a predetermined shape by expanding at selective positions of a back surface of the mirror unit," as recited in independent claim 1.

Cao describes that "it is possible for mirror 254 to also be a concave or a convex mirror when viewed by the top," See column 19, lines 52-54. However, Cao merely suggests that the mirror 254 may be exchanged between the concave or the convex type, not that the mirror 254 may be transformed into a different shape. Specifically, Cao is associated with a method in which the shape of a mirror face is not variable. For this reason, the method calls for having a plurality of mirrors with differently shaped faces and switch from one to another.

It is not possible to provide one wavelength dispersion compensator with all the necessary mirror variations to accommodate compensation amounts that may be required in a scale associated with the worldwide networks. Furthermore, the variable wavelength dispersion compensator, in accordance with an aspect of the present invention, avoids experiencing communication interruptions in correspondence to every switchover between mirrors at which a beam from the VIPA crosses a mirror joint. In contrast to the present invention, in systems where a larger number of mirrors is provided, the larger the size of the assembly becomes and requires a more complex operation.

In the Office Action, at page 4, claim 3 was rejected under 35 U.S.C. § 103 over Cao. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Claim 3 depends from independent claim 1. Thus, the arguments presented above supporting the patentability of independent claim 1 are incorporated herein to support the patentability of dependent claim 3.

The claimed feature of dependent claim 3 is rejected by conclusively asserting that the feature is well known in the art. However, it is improper to merely deem something obvious without any teaching/suggestion, or the taking of Judicial Notice. If the U.S. Patent and Trademark Office wishes to take Judicial Notice that the proposed structural and functional

modification is notoriously well known, supporting evidence must be provided. The Federal Circuit has cautioned that an Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. In re Rouffet, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

As applied to the determination of patentability when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section." See In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002), (citing In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983)). The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See In re Lee, 61 USPQ2d 1430 (CA FC 2002), (citing McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("The central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors)). Accordingly, evidence must be provided from the prior art of some teaching, motivation, or suggestion to select and combine the references.

No such showing has been made in the present Office Action. It is submitted that the reason why no such showing was made is because the prior art of record individually or combined, fail to teach, suggest, or otherwise provide the motivation needed to make such a modification. Accordingly, evidence through a reference or such or that an Affidavit must be presented, or the rejection must be withdrawn

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution

can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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